

1 Audra L. Thompson (SBN 218479)
2 DUANE MORRIS LLP
3 865 S. Figueroa St., Suite 3100
4 Los Angeles, CA 90017-5450
5 Telephone: (213) 689-7400
6 Facsimile: (213) 689-7401
7 E-mail: AThompson@duanemorris.com

8 Gregory P. Gulia (*admitted pro hac vice*)
9 Vanessa C. Hew (*admitted pro hac vice*)
DUANE MORRIS LLP
1540 Broadway
10 New York, New York 10036-4086
11 Telephone: (212) 692-1000
12 Facsimile: (212) 692-1020
13 E-mail: GPGulia@duanemorris.com
14 VCHew@duanemorris.com

15 Attorneys for Plaintiff
16 Conopco, Inc. d/b/a Unilever
17

18 **UNITED STATES DISTRICT COURT**

19 **CENTRAL DISTRICT OF CALIFORNIA**

20 CONOPCO, INC. d/b/a UNILEVER

21 Plaintiff,

22 v.

23 P.E. RUBALOFF CO., INC., KAREN
24 RUBALOFF and PHILLIP RUBALOFF

25 Defendants.

26 Case No.: 2:12-cv-10591-JAK-JC

27 DISCOVERY MATTER

28 **JOINT RULE 16(b) REPORT**

Date: June 24, 2013

Time: 01:30 p.m.

Judge: Hon. John A. Kronstadt

Courtroom: 750

Date Complaint Filed: 12/11/2012

29 Plaintiff Conopco, Inc. d/b/a Unilever (hereinafter, "Unilever" or "Plaintiff")
30 and Defendants P.E. Rubaloff Co., Inc. a/k/a Soap Man, Karen Rubaloff and Phillip
31 Rubaloff (collectively the "Defendants"), by and through their respective counsel,
32 submit this report and plan pursuant to Rule 16(b) and this Court's Initial Standing
33 Order dated January 25, 2013. Plaintiff and Defendants (collectively, the "Parties")
34

1 reserve the right to supplement the Rule 16(b) Report as may be warranted upon the
2 discovery of additional facts and other information in discovery.

3 **RULE 16(b) Topics**

4 **A. STATEMENT OF THE CASE**

5 **1. Plaintiff's Claims**

6 This is an action for trademark counterfeiting, trademark infringement,
7 trademark dilution and unfair competition with respect to Plaintiff's federally
8 registered and famous DOVE® trademarks (collectively, the "DOVE® Mark") in
9 connection with beauty, skin care and other personal care products.

10 Plaintiff owns the exclusive trademark rights to DOVE®. Plaintiff holds
11 numerous federal trademark registrations on the Principal Register of the United
12 States Patent and Trademark Office for the DOVE® Mark for a vast and diverse
13 assortment of skin and other beauty care products. The DOVE® Mark has acquired
14 enormous value and is famous nationwide as a result of Plaintiff's investment of labor
15 and many millions of dollars in advertising, promoting, marketing and developing
16 Plaintiff's DOVE® Mark and the products and services sold thereunder. In particular,
17 the volume of sales of goods under the DOVE® Mark in the United States has been
18 enormous and customers expect high quality when purchasing DOVE® brand
19 products.

20 Defendants import, market, distribute, supply and sell products bearing the
21 DOVE® Mark, which are not intended for sale in the United States and are materially
22 different from the authentic goods that are authorized by Plaintiff for sale in the
23 United States market (hereinafter "Unauthorized Products").

24 Plaintiff contends that Defendants' actions constitute trademark counterfeiting,
25 federal trademark infringement, trademark dilution and unfair competition under
26 Sections 32(1), 43(c) and 43(a) of the Trademark Act of 1946 (the "Lanham Act"), 15
27 U.S.C. §§ 1114(1), 1125(c) and 1125(a), as well as substantial and related claims of
28

1 unfair competition and dilution under the state and common laws of the State of
2 California.

3 Plaintiff seeks damages and injunctive relief.

4 **2. Counterclaims**

5 Defendants have not asserted any counterclaims.

6 **3. Affirmative Defenses**

7 Defendants have asserted the affirmative defenses of estoppel, laches,
8 acquiescence and waiver based on the fact that Plaintiff first objected to the acts of
9 Defendants which are the subject of the present complaint over three (3) years before
10 commencing this action. At that time, Defendants' counsel explained to Plaintiff's
11 attorneys what Defendant was doing and why it did not infringe Plaintiff's rights.
12 Plaintiff did not respond to Defendant's denial of wrongdoing. In view thereof,
13 Defendant, P.E. Rubaloff Co., Inc. ("Rubaloff") continued to distribute the accused
14 products but would have stopped doing so to avoid a lawsuit. In this regard, upon
15 receipt of the present Complaint and pursuant to communications with Plaintiff's
16 attorneys, Rubaloff has voluntarily ceased all sales of the accused products; issued a
17 recall of the products and produced all of its sales data to Plaintiff. In view thereof, the
18 principles of equity bar a monetary recovery.

19 Defendants have also asserted that Plaintiff's attempts to bar Defendants from
20 re-selling Plaintiff's products which Rubaloff has lawfully purchased in the United
21 States constitutes unclean hands which bars the relief which Plaintiff seeks.

22
23 **B. SUBJECT MATTER JURISDICTION**

24 The Court has jurisdiction over this proceeding pursuant to Section 39 of the
25 Lanham Act, 15 U.S.C. §§ 1121, 1338(a) and 1338(b) of the Judicial Code, 28 U.S.C.
26 § 1338(a) and § 1338(b), and under principles of supplemental jurisdiction. Venue
27 properly lies in this District under Sections 1391(b) and (c) of the Judicial Code, 28
28 U.S.C. § 1391(b) and § 1391(c), because Defendants P.E. Rubaloff Co., Inc. a/k/a

1 Soap Man (“P.E. Rubaloff”), Karen Rubaloff and Phillip Rubaloff do business in
2 and/or have substantial contacts with and/or may be found in the Central District of
3 California, and a substantial portion of the events at issue have arisen and/or will arise
4 in this judicial district. Defendants market, distribute, supply and sell the
5 Unauthorized Products through third-party distributors and retailers, throughout the
6 United States, including but not limited to, in the state of California. Defendants
7 should reasonably expect their infringing activities to have consequences in the state
8 of California, and derive substantial revenue from interstate commerce. In addition,
9 Defendants are all residents of the State of California and operate their business and
10 import, distribute and sell the products at issue in this litigation in the State of
11 California. Defendants may reasonably anticipate being brought into a California
12 court. This Court has personal jurisdiction over Defendants because, upon
13 information and belief, they reside and operate their business in the State of California
14 and purposefully availed themselves of the laws of California by actively controlling
15 and/or directing, in whole or in part, the infringing activities and operations
16 complained of herein.

17 **C. LEGAL ISSUES**

18 This is an action for trademark counterfeiting, trademark infringement,
19 trademark dilution and unfair competition with respect to Plaintiff’s federally
20 registered and famous DOVE® Mark. The action arises out of Defendants’
21 unauthorized past, current and planned importation, distribution, offering for
22 sale and/or sale of products bearing the DOVE® trademarks, which are not
23 intended for sale in the United States and are materially different from the
24 authentic DOVE® products that are authorized by Plaintiff for sale in the
25 United States market. Defendants’ Unauthorized Products violate Plaintiff’s
26 longstanding and extensive rights in the use of its famous DOVE® Mark in
27 connection with beauty, skin care and other personal care products.

28

1 Defendants have asserted the affirmative defenses of estoppel, laches,
 2 acquiescence and waiver based on the fact that Plaintiff first objected to the acts of
 3 Defendants which are the subject of the present complaint over three (3) years before
 4 commencing this action. At that time, Defendants' counsel explained to Plaintiff's
 5 attorneys what Defendant was doing and why it did not infringe Plaintiff's rights.
 6 Plaintiff did not respond to Defendant's denial of wrongdoing. In view thereof,
 7 Defendant, P.E. Rubaloff Co., Inc. ("Rubaloff") continued to distribute the accused
 8 products but would have stopped doing so to avoid a lawsuit. In view thereof, the
 9 principles of equity bar a monetary recovery.

10 Defendants have also asserted that Plaintiff's attempts to bar Defendants from
 11 re-selling Plaintiff's products which Rubaloff has lawfully purchased in the United
 12 States constitutes unclean hands which bars the relief which Plaintiff seeks.

13

14 **D. PARTIES, AND NON-PARTY WITNESSES/KEY DOCUMENTS**
 15 **ON THE CORE ISSUES OF THE CASE:**

16 1. As currently advised, percipient witnesses in this litigation include:
 17 a. For Plaintiff:

| | | |
|------------------|-----------------------------------------------------------------|-------------------------------------------|
| Karen Rubaloff | Co-owner and registered agent of P.E. Rubaloff Co., Inc. | To Be Contact Through Defendants' Counsel |
| Phillip Rubaloff | Co-owner and registered agent of P.E. Rubaloff Co., Inc. | To Be Contact Through Defendants' Counsel |
| Kimberly Strokes | Region Sales Manager, Southern California at Unilever | To Be Contact Through Plaintiff's Counsel |
| Andrew Hotchkiss | Associate Region Sales Manager, Southern California at Unilever | To Be Contact Through Plaintiff's Counsel |
| Glenn Mead | Retail Development Manager at Unilever | To Be Contact Through Plaintiff's Counsel |

| | | | |
|---|--------------|-----------------------------------------------|-------------------------------------------|
| 1 | Vinit Patel | Director of Sales - West Division at Unilever | To Be Contact Through Plaintiff's Counsel |
| 2 | Russel Lilly | Marketing Director at Unilever | To Be Contact Through Plaintiff's Counsel |

4

5 b. For Defendants:

6

| | | | |
|----|------------------------------|--|--|
| 7 | Phillip Rubaloff | | |
| 8 | Representatives of Plaintiff | | |
| 9 | | | |
| 10 | | | |

11

12

2. As presently advised, key documents in this litigation include:

13

a. For Plaintiff:

14

15 Documents regarding Plaintiff's marketing, distribution, sale, advertising and
16 promotion of the DOVE® Mark

17

18 Trademark Registration Certificates for the DOVE® Mark

19

20 Documents regarding Plaintiff's products

21

22 Documents regarding Plaintiff's products' packaging and labeling

23

24 Documents regarding Plaintiff's products' distribution

25

26 Documents regarding Plaintiff's damages arising from Defendants' infringing
27 activities

28

29 Documents regarding Defendants' unauthorized sale, advertisement or marketing
30 of any Unauthorized Products bearing the DOVE® Mark

31

32 Documents regarding Defendants' unauthorized repackaging and relabeling of
33 any Unauthorized Products bearing the DOVE® Mark

34

35 Documents regarding Defendants' unauthorized use of the DOVE® Mark

Documents regarding Defendants' sales and profits

Documents regarding Defendants' purchase of the Unauthorized Products

b. For Defendants:

The accused products

Correspondence from and to Plaintiff's attorney

E. DAMAGES:

Under trademark law, injury is presumed from the mere likelihood of confusion because infringement places the owner's reputation, and that of its goods and services, beyond its control. The Parties have not yet engaged in discovery. Accordingly, a determination regarding the probable range of damages is not possible until the Parties obtain evidence and information from discovery procedures.

As for Plaintiff's entitlement to damages, see Defendant's discussion of legal issues and affirmative defenses above.

F. INSURANCE:

None

G. MOTIONS:

Plaintiff has recently discovered that Defendants are infringing Plaintiff's CARESS® and LEVER 2000® trademarks. Plaintiff intends to seek the Court's leave to amend the complaint to include these additional claims.

1 **H. MANUAL FOR COMPLEX LITIGATION:**

2 The Parties do not believe this is a complex case or that the Manual for
3 Complex Litigation should be utilized.

4 **I. STATUS OF DISCOVERY:**

5 At this time, the Parties have not exchanged written discovery requests. The
6 Parties have agreed to make their respective initial disclosures pursuant to Federal
7 Rule of Civil Procedure, Rule 26(a)(1)(A) on or before June 24, 2013.

8 Although no formal discovery has taken place to date, Rubaloff has produced
9 all of its sales documents relating to the accused goods in response to a demand from
10 Plaintiffs' attorney, who ostensibly made this demand to facilitate settlement of this
11 case.

12 **J. DISCOVERY PLAN:**

13 **1. RULE 26(f)(2): Discovery Needed by Plaintiff**

14 **a. Written Discovery**

15 As presently advised, Plaintiff anticipates written discovery requests, including
16 requests for admission, document requests, and written interrogatories, will be
17 required on the following issues among others: (1) evidence regarding Defendants'
18 violations of Plaintiff's DOVE® Mark and the nature and length of time of such
19 activities; (2) Defendants' purchase, importation, marketing, distribution, and/or
20 promotion of the Unauthorized Products; (3) Defendants' Unauthorized Products
21 bearing the DOVE® Mark, including but not limited to their product packaging,
22 labeling and/or compliance with the Food and Drug Administration; and (4)
23 Defendants' revenue and profits realized as a result of Defendants' violation of
24 Unilever's intellectual property rights.

25 **b. Depositions**

26 In addition, Plaintiff anticipates deposing the witnesses pursuant to Rule
27 30(b)(6) as to the above mentioned topics, as well as Karen Rubaloff and Phillip
28 Rubaloff.

1 **2. Rule 26(f)(2): Discovery Needed by Defendants**

2 Defendants anticipate posing interrogatories, requests for admissions and for
3 production of documents, and depositions concerning Plaintiff's allegations.

4 **3. Rule 26(f)(3): Limitations on Discovery**

5 At this time, the Parties do not anticipate that any changes to or limitations of
6 the discovery procedures, as set forth in the Federal Rules, will be necessary.

7 **4. Rule 26(f)(3): Issues Regarding Electronic Discovery**

8 Because the Parties' communications and records are mostly in paper form, the
9 Parties expect that relatively little discoverable information is in electronic form, and
10 that given the size of this dispute, electronic discovery may not be warranted in this
11 matter. To the extent that any discoverable information is in electronic form, the
12 Parties agree to take reasonable steps to preserve electronically stored information and
13 that electronically stored information will be produced as follows: (a) as scanned
14 copies of the electronically stored information; or (b) as hard copies of the
15 electronically stored information; or (c) by any other method later agreed upon by the
16 Parties.

17 **5. Other Orders Pursuant to Rule 26(f)(4)**

18 The Parties anticipate that various confidential proprietary and financial
19 documents and other information and materials will be produced in connection with
20 discovery. The Parties expect to submit a Stipulated Protective Order under Rule
21 26(c) for review and approval by the Court.

22 **6. Proposed Deadlines**

23 See Schedule of Pretrial and Trial Dates attached as Exhibit A.

24 **K. DISCOVERY CUT-OFF:**

25 The Parties propose that the non-expert discovery cut-off date be January 27,
26 2014.

L. EXPERT DISCOVERY:

The Parties propose the following dates for expert witness disclosures (initial and rebuttal) and expert discovery cut-off : Monday February 3, 2014, Monday March 3, 2014 and March 24, 2014.

M. DISPOSITIVE MOTIONS:

Motions *in limine* may be appropriate as evidentiary issues develop.

There are no contemplated motions at this time, but they may appear as discovery progresses. Proposed motion cut-off date is March 24, 2014.

N. SETTLEMENT:

The Parties have participated in telephone conferences and exchanged documents regarding settlement. A settlement agreement has been drafted and the Parties have engaged in settlement negotiations but failed to settle and resolve all disputes and claims arising from all transactions and occurrences that form the basis of the Civil Action. In addition, Plaintiff has recently discovered new facts regarding additional infringements by Defendants and intends to seek the Court's leave to amend the Complaint in this Civil Action. The parties select ADR Procedure No. 1. The parties shall appear before the district judge or magistrate judge assigned to the case for such settlement proceedings as the judge may conduct or direct.

O. TRIAL ESTIMATE:

Plaintiff anticipates that the jury trial will last 3-4 days. The proposed number of witnesses is currently unknown.

P. TRIAL COUNSEL:

The attorney(s) who will try the case for Plaintiff are Audra L. Thompson, Duane Morris LLP, 865 S. Figueroa St., Suite 3100, Los Angeles, CA 90017-5450, Gregory P. Gulia (*admitted pro hac vice*) and Vanessa C. Hew (*admitted pro hac vice*) Duane Morris LLP, 1540 Broadway, New York, New York 10036-4086. Lead trial counsel for Plaintiff is Gregory P. Gulia.

1 The attorneys who will try the case for Defendants are Edward R. Schwartz,
2 David A. Dillard and Thomas J. Daly, Christie, Parker & Hale, LLP, 655 N. Central
3 Avenue, Glendale, California 91203. Lead trial counsel for Defendants is Edward R.
4 Schwartz.

5 **Q. INDEPENDENT EXPERT OR MASTER:**

6 The Parties do not believe that an independent expert or special master is
7 necessary in this matter.

8 **R. TIMETABLE:**

9 The Parties propose that trial be held on or around Tuesday May 20, 2014, with
10 the Pretrial Conference on or about Monday May 5, 2014.

11 See Schedule of Pretrial and Trial Dates attached as Exhibit A.

12 **S. OTHER ISSUES:**

13 None known at this time.

14 **T. PATENT CASES:**

15 N/A.

16 **U. IDENTITY OF ALL CORPORATE SUBSIDIARIES, PARENTS AND**
17 **AFFILIATES**

18 Plaintiff Conopco, Inc. d/b/a Unilever is an indirect subsidiary of Unilever N.V.
19 and Unilever PLC, both of which are publicly traded companies.

20 **V. DO THE PARTIES WISH TO HAVE A MAGISTRATE JUDGE**
21 **PRESIDE?**

22 The Parties do not wish to have a Magistrate Judge preside over all the
23 proceedings.

1 Respectfully Submitted,
2 Dated: June 17, 2013

DUANE MORRIS LLP

3 By: s/ Audra L. Thompson
4

5 Audra L. Thompson (SBN 218479)
6 865 S. Figueroa St., Suite 3100
7 Los Angeles, CA 90017-5450
8 Telephone: (213) 689-7400
9 Facsimile: (213) 689-7401

10 and
11

12 Gregory P. Gulia(admitted *pro hac vice*)
13 Vanessa C. Hew (admitted *pro hac vice*)
14 1540 Broadway
15 New York, New York 10036-4086
16 Telephone: (212) 692-1000
17 Facsimile: (212) 692-1020
18 Email address:GPGulia@duanemorris.com
19 VCHew@duanemorris.com

20 Attorneys for Plaintiff
21 Conopco, Inc. d/b/a Unilever

22 Dated: June 17, 2013

CHRISTIE PARKER HALE LLP

23 By: s/ Edward R. Schwartz
24

25 Edward R. Schwartz (SBN 147553)
26 655 N Central Ave #2300
27 Glendale, California 91203
28 Telephone: (626) 795-9900
Facsimile: (626) 577-8800
Email address:Edward.Schwartz@cph.com

Attorneys for Defendants
P.E. Rubaloff Co., Inc., Karen Rubaloff and
Phillip Rubaloff

(